

**REMARKS**

Claims 1 and 6-18 are all the claims now pending in the application.

Claims 1 and 6-17 are rejected under 35 U.S.C 102(a) as being anticipated by Higuchi (JP 11-253578). To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and limitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus the reference must clearly and unequivocally disclose every element and limitation of the claimed invention. Higuchi fails to teach all of the limitations of the claims.

Higuchi fails to teach that the mantle is made from a thermoplastic elastomer selected from the group consisting of polyester, polyamide, polyolefin, and polystyrene. Higuchi teaches a golf ball having an intermediate layer (mantle layer) that must be formed primarily of a polyurethane resin. However, polyurethane is not one of the thermoplastic elastomers recited in claim 1 because the use of thermoplastic polyurethane elastomers is inferior. Specifically, thermoplastic polyurethane elastomers have a comparatively low rebound, and thus inferior flight performance, when used in the mantle layer compared to the materials recited in claim 1. More specifically, in low temperatures, the rebound of a golf ball having a mantle layer made of thermoplastic polyurethane elastomers is lower than a golf ball having a mantle layer made from the materials recited in claim 1.

Additionally, the Examiner concludes that all of the limitations of the claims are explicitly taught except for the compression ratio (mantle/core) being at least 0.98. The Examiner then alleges that the compression ratio would be an inherent feature of the Higuchi

golf ball because the deflection ranges disclosed in Higuchi of the mantle and core are the same as recited in the claims.

A prior art patent may not be assumed to contain inherently a claim limitation simply because the reference discloses the same structure. *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1377 (Fed. Cir. 2002). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); MPEP§ 2112. Thus, simply because the deflection ranges overlap those of claim 1, it does not necessarily indicate that the compression ratio is within the claimed range. For example, Comparative Examples, 1-3 in Table 3 of the present specification, illustrate deflection values for the mantle and core that fall within the claimed ranges but each have a compression ratio that does not fall within the claimed range. Accordingly, although the deflection ranges of the mantle and core fall within the claimed ranges, it does not necessarily establish that the compression ratio is within the claimed range. Therefore, Applicant submits that has failed to show that this ratio is inherently taught by Higuchi.

In view of the above remarks, Applicant submits that Higuchi fails to teach the all of the limitations of claim 1. Accordingly, Applicant requests that the rejection of claim 1 under 35 U.S.C. § 102(a) be reconsidered and withdrawn.

AMENDMENT UNDER 37 C.F.R. § 1.111  
Appln. No.: 09/667,301

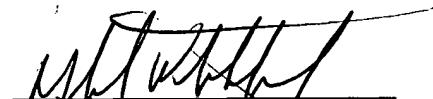
Attorney Docket No.: Q60969

Since claims 6-17 depend from claim 1, and since the Higuchi reference does not disclose all of the limitations of claim 1, Applicant submits that claims 6-17 are patentable at least by virtue of their dependency from claim 1. Accordingly, Applicant respectfully requests that the rejections of claims 6-17 under 35 U.S.C. § 102(a) be reconsidered and withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



\_\_\_\_\_  
Michael J. Whitehead  
Registration No. 48,071

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE  
**23373**  
CUSTOMER NUMBER

Date: August 5, 2003